

PATENT
Docket No: 041892.0206

#5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Todd OUTTEN, Chris RUSSELL, Bryan Gentry SPAULDING, Scott Jeffrey SHERR, Ira Steven RUBENSTEIN, Yair LANDAU, Brian David LAKAMP, Jeremy Eli BARNETT, Douglas D. CHEY, Michael R. ARIETTA, Mary KORMAN, Harish MANDYAM, Thomas R. RODRIGUEZ, Andrew MOSSON, Ernesto BRODERSOHN, and Mary ABRAHAM

Serial No. 09/827,481

Filed: April 6, 2001

For: **SYSTEM AND PROCESS FOR DELIVERY OF CONTENT OVER A NETWORK**

**PETITION IN SUPPORT OF FILING ON BEHALF OF
OMITTED INVENTOR
UNDER 35 U.S.C. 116 AND 37 C.F.R. 1.47**

Pursuant to 37 CFR § 1.47(a), applicants herewith Petition the Commissioner to accept the accompanying Declaration executed by co-inventors Todd Outten, Bryan Gentry Spaulding, Scott Jeffrey Sherr, Ira Steven Rubenstein, Yair Landau, Douglas D. Chey, Michael R. Arietta, Harish Mandyam and Thomas R. Rodriguez on behalf of themselves and omitted co-inventors Chris Russell, Brian David Lakamp, Jeremy Eli Barnett, Mary Korman, Andrew Mosson, Ernesto Brodersohn, and Mary Abraham.

Attorney for applicants has diligently attempted to reach the above-named omitted co-inventors without success, as documented in the Declaration accompanying this Petition. Therefore, applicants request that the Commissioner grant the instant petition and allow the above-named signing co-inventors to pursue the application, as provided by 37 CFR § 1.47(a), on behalf of the above-named omitted co-inventors.

**OMITTED CO-INVENTORS' LEGAL OBLIGATION TO ASSIGN
INVENTION**

Six of the omitted co-inventors (Brian David Lakamp, Jeremy Eli Barnett, Mary Korman, Andrew Mosson, Ernesto Brodersohn, and Mary Abraham) signed a "Confidential Information and Invention Assignment Agreement" with Viant Corporation, assigning all their rights to any inventions which they conceived or developed or reduced to practice, or caused to be conceived or developed reduced to practice, during the period of their employment.

The above-referenced Agreements indicate that the six omitted co-inventors named above were, at the time of signing the Agreements, employees of Viant Corporation. (See paragraphs 2 and 3 of the Declaration accompanying this Petition in support of these contentions.)

In addition, Viant Corporation entered into a "Master Services Agreement" with Sony Pictures Digital Entertainment, Inc. wherein all right, title, and interest in and to any technology or information otherwise developed or created solely for Sony Pictures Digital Entertainment by Viant would be the property of Sony Pictures Digital Entertainment. (See paragraphs 4 and 5 of the Declaration accompanying this Petition in support of this contention.)

The remaining omitted co-inventor (Chris Russell) signed an "Employment Agreement" with Sony Pictures Entertainment, Inc. That Agreement incorporates by reference a document titled "Exhibit A Standard Terms and Conditions of Employment Agreement" which states that the Company (Sony Pictures Entertainment, Inc.) shall be the sole and exclusive owner of all Intellectual Property which the Employee (Mr. Russell) may develop, create, write or otherwise produce during the Employment Period.

The above-referenced Agreement indicates that Mr. Russell was, at the time of signing the Agreement, an employee of Sony Pictures Entertainment, Inc. (See paragraphs 19 and 20 of the Declaration accompanying this Petition in support of these contentions.)

Therefore, the above-referenced agreements show that all of the omitted co-inventors named above have a legal obligation to assign all their right, title, and interest in and to the invention described in the above-designated application to the assignee, as indicated by the "Confidential Information and Invention Assignment Agreement," the "Master Services Agreement between Viant and Sony Pictures Digital Entertainment, Inc." and the "Employment Agreement."

DETAILS OF EFFORTS TO REACH OMITTED CO-INVENTORS

Applicants' attorney made diligent efforts to reach all of the omitted co-inventors without success. These efforts included mailing assignment and declaration forms to the last known addresses of the omitted co-inventors, as well as contacting attorneys employed by both Sony Pictures Digital Entertainment, Inc. and Viant to request assistance in obtaining the omitted co-inventors' signatures on the assignment and declaration forms.

Specifically, on August 10, 2001, the undersigned prepared and mailed letters to the last known address of each of the omitted co-inventors named in the above-designated patent application. The addresses of six of the omitted co-inventors named above (Brian David Lakamp, Jeremy Eli Barnett, Mary Korman, Andrew Mosson, Ernesto Brodersohn, and Mary Abraham) were provided to applicants' attorney by Brennan Wall, Esq., a Viant attorney. The address of the remaining omitted co-inventor (Chris Russell) was provided by a Sony representative. Each letter included, as enclosures, a copy of the application, an assignment form, and a declaration form. Each inventor was asked to review the enclosed patent application and to sign and return the assignment and declaration forms no later than August 17, 2001. (See paragraphs 7, 8 and 21 of the Declaration accompanying this Petition.)

However, each of the omitted co-inventors named in the above-designated patent application either did not execute and return either of the declaration and assignment documents (Brian David Lakamp, Ernesto Brodersohn, and Mary Abraham), or executed and returned only the assignment document (Jeremy Eli

Barnett, Mary Korman, and Andrew Mosson). (See paragraph 9 of the Declaration accompanying this Petition.)

In a further effort to reach omitted co-inventor Brian Lakamp, a letter, dated September 19, 2001, was prepared and mailed by applicants' attorney to Susie Oh, Esq., an attorney at Sony Pictures Entertainment, asking for assistance in having Mr. Lakamp sign and return the assignment and declaration forms that were enclosed with the letter. (See paragraph 12 of the Declaration accompanying this Petition.)

Brian Lakamp was informed on September 20, 2001, by an e-mail sent to him by Ms. Oh, that she had "patent applications which require your signature," and was asked by Ms. Oh whether she should send them to him (Mr. Lakamp) or whether he would pick them up. Mr. Lakamp, by a return e-mail with the same date, stated that "accommodations for my signature should be handled through the agreements with Viant [his former employer], since all related IP was developed during my tenure there." Ms. Oh then requested, in an e-mail sent to applicants' attorney on the same date, advice about how to proceed with Mr. Lakamp. (See paragraphs 13, 14, and 15 of the Declaration accompanying this Petition.)

Applicants' attorney then advised Ms. Oh, in an e-mail dated September 24, 2001, to inform Mr. Lakamp that the declaration is a United States Patent and Trademark Office requirement imposed on each inventor and that it cannot be satisfied through other agreements. Ms. Oh then contacted Mr. Lakamp, by an e-mail dated September 25, 2001, and informed him, *inter alia*, that "patents are invented by the individual, not the employer of the individual." Ms. Oh then again requested that Mr. Lakamp sign the forms. However, the signed forms have still not been received from Mr. Lakamp. (See paragraphs 16, 17, and 18 of the Declaration accompanying this Petition.)

Thus, the foregoing shows that applicants' attorney made diligent efforts to obtain the signatures of Mr. Lakamp on the assignment and declaration forms. In addition, the foregoing shows that Mr. Lakamp apparently refuses to sign the application papers.

In a further effort to reach omitted co-inventor Chris Russell, a second letter, dated October 1, 2001, was prepared and mailed by applicants' attorney to Mr. Russell. A copy of the application, an assignment form, and a declaration form were enclosed with the second letter. Mr. Russell was asked in the second letter to review the enclosed patent application and to sign and return the assignment and declaration forms no later than October 15, 2001. (See paragraph 23 of the Declaration accompanying this Petition.)

However, the assignment and declaration forms included as enclosures in the second letter sent to Mr. Russell were not executed and returned as of the date of the Declaration accompanying this Petition. In a telephone conference with applicants' attorney, Mr. Russell stated that he is no longer employed by Sony Pictures Entertainment, Inc., and that he will not be signing the assignment and declaration forms. (See paragraphs 24 and 25 of the Declaration accompanying this Petition.)

Thus, the foregoing shows that applicants' attorney made diligent efforts to obtain the signatures of Mr. Russell on the assignment and declaration forms. In addition, the foregoing shows that Mr. Russell apparently refuses to sign the application papers.

In further efforts to reach the remaining five of the above-named omitted co-inventors (Jeremy Eli Barnett, Mary Korman, Andrew Mosson, Ernesto Brodersohn, and Mary Abraham), applicants' attorney prepared and mailed a letter to Mr. Wall, asking for assistance in obtaining the omitted co-inventors' signatures on the assignment and declaration forms. However, signed Declaration forms have still not been received from any of the five above-named omitted co-inventors. (See paragraphs 10 and 11 of the Declaration accompanying this Petition.)

Thus, it is believed that the remaining five of the above-named omitted co-inventors are either unreachable at their last known address or are not cooperating.

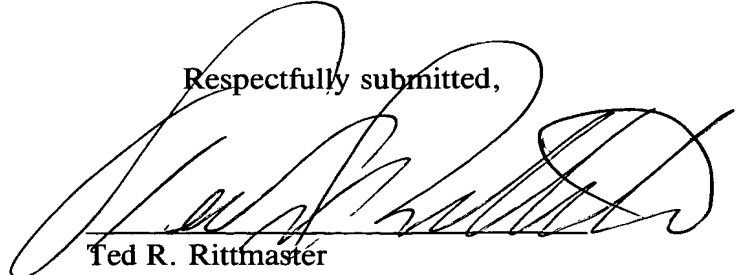
Serial No.: 09/827,481

It is further submitted that diligent efforts were made under the circumstances and that more than a reasonable effort has been made to obtain the signatures of all of the above-named omitted co-inventors on the assignment and declaration forms.

Therefore, it is requested that the present Petition be granted.

Respectfully submitted,

12-27-01
Date


Ted R. Rittmaster
Reg. No. 32,933

FOLEY & LARDNER
2029 Century Park East, 35th Floor
Los Angeles, CA 90067-3021
(310) 277-2223 tel
(310) 557-8475 fax



PATENT
Docket No: 041892-0206

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Todd OUTTEN, Chris RUSSELL, Bryan Gentry SPAULDING, Scott Jeffrey SHERR, Ira Steven RUBENSTEIN, Yair LANDAU, Brian David LAKAMP, Jeremy Eli BARNETT, Douglas D. CHEY, Michael R. ARIETTA, Mary KORMAN, Harish MANDYAM, Thomas R. RODRIGUEZ, Andrew MOSSON, Ernesto BRODERSOHN, and Mary ABRAHAM

Serial No. 09/827,481

Filed: April 6, 2001

For: **SYSTEM AND PROCESS FOR DELIVERY OF CONTENT OVER A NETWORK**

**DECLARATION OF TED RITTMASER IN SUPPORT OF
FILING ON BEHALF OF OMITTED INVENTOR
UNDER 35 U.S.C. 116 AND 37 C.F.R. 1.47**

I, Ted Rittmaster, hereby declare as follows:

1. I am submitting this Declaration with the accompanying "Petition In Support Of Filing On Behalf Of Omitted Inventor Under 35 U.S.C. 116 And 37 C.F.R. 1.47."

2. Attached as Exhibits 1-6 hereto are copies of documents titled "Confidential Information and Invention Assignment Agreement." Each of the six Agreements are between Viant and one of six of the omitted co-inventors (Brian David Lakamp, Jeremy Eli Barnett, Mary Korman, Andrew Mosson, Ernesto Brodersohn, and Mary Abraham). Each of these six Agreements has been signed by one of the six omitted co-inventors.

3. Each of these Agreements (Exhibits 1-6) contains a clause (clause 3(b)) wherein the signing party agrees, *inter alia*, to "hereby assign to the Company [Viant], or its designee, all my right, title, and interest in and to any and all inventions, original works of authorship, developments, concepts, improvements or trade secrets, whether or not

patentable or registrable under copyright or similar laws, which I may solely or jointly conceive or develop or reduce to practice, or cause to be conceived or developed or reduced to practice” during their employment with the Company.

4. Also attached as Exhibit 7 hereto is a copy of a document titled “Master Services Agreement between Viant and Sony Pictures Digital Entertainment, Inc.” This Master Services Agreement contains the signatures of Dwayne Nesmith, designated therein as the Chief Financial Officer of Viant Corporation, and Yair Landau, designated therein as the President of Sony Pictures Digital Entertainment, Inc.

5. This Master Services Agreement (Exhibit 7) includes a clause (clause 4(a)) stating, *inter alia*, that the customer (Sony Pictures Digital Entertainment, Inc.) “shall own all right, title, and interest in and to any technology or information otherwise developed or created solely for customer by Viant, including any intellectual property rights therein.”

6. Also attached as Exhibit 8 hereto is a hardcopy of an e-mail, dated February 28, 2001, sent by me to Brennan Wall, Esq., a Viant attorney, wherein I request Mr. Wall’s assistance in collecting, *inter alia*, the current mailing addresses of omitted co-inventors Brian David Lakamp and Jeremy Barnett.

7. Also attached is a hardcopy of an e-mail (also Exhibit 8), dated March 2, 2001, and sent to me by Mr. Wall, wherein Mr. Wall provides, *inter alia*, addresses for Mr. Lakamp and Mr. Barnett. From my recollection, the addresses of Mary Korman, Andrew Mosson, Ernesto Brodersohn, and Mary Abraham were also provided to me by Mr. Wall during a telephone conference.

8. Also attached as Exhibits 9-14 hereto are copies of letters, dated August 10, 2001, which I prepared and mailed to the addresses provided to me by Mr. Wall for co-

inventors Brian David Lakamp, Jeremy Eli Barnett, Mary Korman, Andrew Mosson, Ernesto Brodersohn, and Mary Abraham. (See paragraph 7.) A copy of the application, an assignment form, and a declaration form were enclosed with each of these letters. Each of these co-inventors was asked in the letters to review the enclosed patent application and to sign and return the assignment and declaration forms no later than August 17, 2001.

9. Neither the executed assignment and declaration forms of Brian David Lakamp, Ernesto Brodersohn, and Mary Abraham, nor the executed declaration forms of Jeremy Eli Barnett, Mary Korman, and Andrew Mosson, were returned to me.

10. Also attached as Exhibit 15 hereto is a copy of a letter, dated October 4, 2001, which I prepared and mailed to Mr. Wall, wherein I reminded him that “we are required to seek signatures from the inventors,” referring, *inter alia*, to the six omitted co-inventors named in paragraph 9 above, and wherein I state that “we again request your assistance in that endeavor.”

11. Neither the executed assignment and declaration forms of Brian David Lakamp, Ernesto Brodersohn, and Mary Abraham, nor the executed declaration forms of Jeremy Eli Barnett, Mary Korman, and Andrew Mosson, were received by me as of the date of this Declaration.

12. Also attached as Exhibit 16 hereto is a copy of a letter, dated September 19, 2001, which I prepared and mailed to Susie Oh, Esq., an attorney at Sony Pictures Entertainment, Inc., asking her to “assist our efforts to have Brian [the omitted co-inventor Brian Lakamp] review and execute the enclosed documents.”

13. Also attached as Exhibit 17 hereto is a hardcopy of an e-mail, dated September 20, 2001 and addressed from Ms. Oh to Mr. Lakamp. This e-mail informs Mr. Lakamp that Ms. Oh has “patent applications which require your signature,” and in the e-

mail Ms. Oh asks Mr. Lakamp “[w]ould you like me to go to you or would you prefer to come over here to sign them?”

14. An e-mail (also Exhibit 17), dated September 20, 2001 and sent by Mr. Lakamp to Ms. Oh after receipt of her e-mail (Exhibit 17), contains the statement: “accommodations for my signature should be handled through the agreements with Viant, since all related IP was developed during my tenure there.”

15. An e-mail (also Exhibit 17), dated September 20, 2001, was received by me from Ms. Oh, requesting that I advise her about how to proceed with Mr. Lakamp, referring to Mr. Lakamp’s statement noted in paragraph 14.

16. Also attached as Exhibit 18 hereto is a hardcopy of an e-mail, dated September 24, 2001, wherein I advise Ms. Oh to inform Mr. Lakamp that the “Inventor’s Declaration is a USPTO requirement imposed on each inventor (and, can not be accommodated through other agreements).”

17. An e-mail (also Exhibit 18), dated September 25, 2001 and addressed to Mr. Lakamp from Ms. Oh, states, *inter alia*, that “patents are invented by the individual, not the employer of the individual.” Ms. Oh then states that “we would rather just have you sign the docs to indicate that you are an inventor, as opposed to filing additional documents with the PTO regarding your lack of signature.”

18. Executed assignment and declaration forms of Mr. Lakamp have not been received by me as of the date of this Declaration.

19. Also attached as Exhibit 19 hereto is a redacted copy of a document titled "Employment Agreement." The agreement is between Sony Pictures Entertainment, Inc. and one of the omitted co-inventors, Chris Russell. The agreement has been signed by Mr. Russell.

20. The Agreement (Exhibit 19) incorporates by reference a document titled "Exhibit A Standard Terms and Conditions of Employment Agreement" (also included in Exhibit 19) which contains a clause (clause 6(a)(i) stating, *inter alia*, that "The Company [Sony Pictures Entertainment, Inc.] shall be the sole and exclusive owner throughout the universe in perpetuity of all of the results and proceeds of Employee's services, work, and labor during the Employment Period in connection with Employee's employment by the Company, including without limitation all Intellectual Property which Employee may develop, create, write or otherwise produce during the Employment Period, free and clear of any and all claims, liens or encumbrances."

21. Also attached as Exhibit 20 hereto is a copy of a letter, dated August 10, 2001, which I prepared and mailed to Chris Russell, the remaining omitted co-inventor. From my recollection, the address for Mr. Russell was provided to me by a Sony representative during a telephone conference. A copy of the application, an assignment form, and a declaration form were enclosed with the letter. Mr. Russell was asked in the letter to review the enclosed patent application and to sign and return the assignment and declaration forms no later than August 17, 2001.

22. The assignment and declaration forms included as enclosures in the letter (Exhibit 20) sent to Mr. Russell were not executed and returned to me.

23. Also attached as Exhibit 21 hereto is a copy of a second letter, dated October 1, 2001, which I prepared and mailed to Mr. Russell. A copy of the application,

an assignment form, and a declaration form were enclosed with the second letter. Mr. Russell was asked in the second letter to review the enclosed patent application and to sign and return the assignment and declaration forms no later than October 15, 2001.

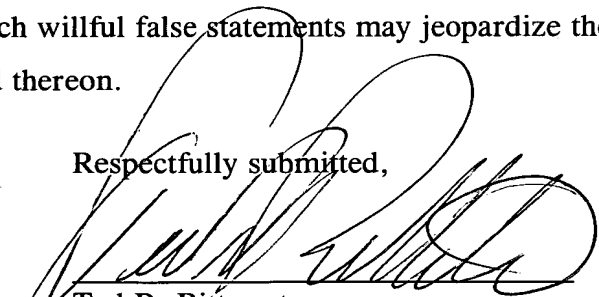
24. The assignment and declaration forms included as enclosures in the second letter (Exhibit 21) sent to Mr. Russell were not executed and returned to me as of the date of this Declaration.

25. In a telephone conference, Mr. Russell informed me that he is no longer employed by Sony Pictures Entertainment, Inc., and that he received the documents sent on October 1, 2001, but will not be signing the assignment and declaration forms.

26. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

12-27-01
Date

Respectfully submitted,


Ted R. Rittmaster
Reg. No. 32,933

FOLEY & LARDNER
2029 Century Park East, 35th Floor
Los Angeles, CA 90067-3021
(310) 277-2223 tel
(310) 557-8475 fax

LAST KNOWN ADDRESS OF THE OMITTED INVENTORS



Full name of omitted inventor:

Brian David Lakamp

Last known address of omitted inventor:

18131 Kingsport Drive, Malibu, California 90265

Full name of omitted inventor:

Jeremy E. Barnett

Last known address of omitted inventor:

563 Via de la Paz, Pacific Palisades, California 90272

Full name of omitted inventor:

Mary Korman

Last known address of omitted inventor:

231 Windward Avenue, Venice, California 90291

Full name of omitted inventor:

Andrew Mosson

Last known address of omitted inventor:

2367 Chestnut Street, San Francisco, California 94123

Serial No.: 09/826,374

Full name of omitted inventor:

Ernesto Brodersohn

Last known address of omitted inventor:

1210 Floribunda Avenue #2, Burlingame, California 94010

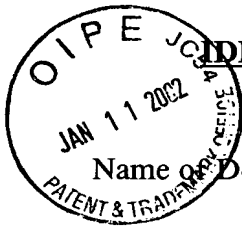
Full name of omitted inventor:

Mary Abraham

Last known address of omitted inventor:

6252 E. Sunnycrest Drive, Oak Park, California 91377

Serial No.: 09/827,481



**IDENTIFICATION OF PERSON MAKING THIS
DECLARATION**

Name of Declarant:

Ted R. Rittmaster

Address of Declarant:

FOLEY & LARDNER

2029 Century Park East, 35th Floor

Los Angeles, CA 90067-3021

FEE

A check for \$130.00, as prescribed by 37 C.F.R. 1.17(h) accompanies this Petition and Declaration. The Commissioner is authorized to charge any underpayment or credit any overpayment to deposit account No. 50-0872.

01/15/2002 CCHAU1 00000027 09827481

03 FC:122

130.00 OP

015.519414.1